

REMARKS/ARGUMENTS

Claims 5-7 are amended to correctly recite dependency on Claim 2, which first introduces a "database rights and restriction report." Claim 40 is amended to correctly recite dependency on Claim 29, which first introduces "the reference signal abstract is digitally signed before it is embedded." Claims 37 and 40 are amended to correct typographical errors by replacing "identify" with "identity". Claims 43-45 are amended to correct typographical errors by replacing "signature" with "signal".

Rejections under 35 U.S.C. § 102

§ 102 Rejections based on Miwa et al.

Claims 1, 3, 7-10, 12-40, 51-53, and 55-61 stand rejected as allegedly anticipated by U.S. Patent No. 6,230,268 issued to Miwa et al. (hereafter Miwa). (See page 3 of the Office Action).

Claim 1 (and all claims depending therefrom)

In order for a reference to anticipate a claim, the reference must disclose each and every limitation of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. See *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Independent Claim 1 recites, *inter alia*, "a reference database that stores abstracts of each at least one reference signal" and "a device that permits submission of reference abstracts to the reference database." The 102 rejection based on Miwa is improper for at least the reason that Miwa fails to disclose the use of a reference database as required by the rejected claims.

Regarding Claim 1, the Examiner asserts that "'a reference database that stores abstracts of each at least one reference signal' and 'a device that permits submission of reference abstracts to the reference database' is inherent." Office Action at 3. The cited reference does not satisfy the standard for inherency for the asserted limitations.

If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed.

Cir. 1991)). In *Continental Can*, the Court explained that "this modest flexibility in the rule that 'anticipation' requires that every element of the claims appear in a single reference accommodates situations in which the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges." 948 F.2d at 1268, 20 USPQ at 1749-50. "In relying upon a theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art." MPEP § 2112 (quoting *Ex parte Levy*, 17 USPQ2d 1361, 1464 (Bd. Pat. App. & Inter. 1990)) (emphasis in original). The Examiner has failed to provide such a basis. The Examiner relies on Figure 6 of Miwa to support the inherency of the foregoing limitations, but Figure 6 teaches away from a reference database meeting the limitations of Claim 1. Miwa describes the content owner side of the process described in Figure 6 as "[a] system of generating a token using an asymmetrical key from an abstract made of a compressed image . . . as another embodiment of a copying control system in digital image distribution." *Miwa*, col. 8, ll. 6-10. On the user side, "an abstract is prepared from a distributed token using a publicly open key and compared with an abstract similarly prepared from a distributed image to verify a match." *Id.* at col. 8, ll. 15-18. There is no suggestion to store the abstract. In fact, the "preparation" of abstracts on the user side teaches away from the required claim limitations, namely "a reference database that stores abstracts of each at least one reference signal" and "a device that permits submission of reference abstracts to the reference database." If the abstracts are stored in a database, there is no need to prepare an abstract at the time of comparison.

Moreover, Claim 1 requires "a comparing device that compares an abstract of said at least one query signal to abstracts stored in the reference database to determine if the abstract of said at least one query signal matches any of the stored abstracts." The Examiner asserts that this limitation is met by "[Figure 6, compare]." As described above, Miwa discloses comparing "an abstract . . . prepared from a distributed token using a publicly open key" to "an abstract similarly prepared from a distributed image to verify a match." *Id.* at col. 8, ll. 15-18. There is no reference to a database, and no reference to a query signal. Miwa fails to describe the comparison of an abstract of at least one query signal with abstracts stored in the reference database as required by Claim 1.

Because Miwa fails to disclose (1) "a reference database that stores abstracts of each at least one reference signal," (2) "a device that permits submission of reference abstracts to the reference database," and (3) "a comparing device that compares an abstract of said at least one query signal to abstracts stored in the reference database to determine if the abstract of said at least one query signal matches any of the stored abstracts" as required by Claim 1, the Section 102 rejection of Claim 1 must be withdrawn. Moreover, for the same reasons that Claim 1 is patentable over Miwa, the claims that depend from Claim 1 also are patentable. Applicants request the Examiner withdraw the Section 102 rejections of Claim 1, 3, 7-10, and 12 based on Miwa.

Claim 7

✓ 1 As amended, Claim 7 depends from Claim 2, and further requires that "the database
2 rights and restrictions report is used to associate content with internal value adding
3 components created by the rightsholder." Examiner asserts that "Pat '268 discloses value-
4 adding components [col 8, line 30]." Examiner fails to address the limitation of a database
5 rights and restrictions report. In fact, the Examiner explicitly states that "Regarding Claim
6 2, Pat '268 . . . does not disclose a database report." Office Action at 7. The Examiner did
7 not reject Claim 2, from which Claim 7 now depends, based on Section 102. In order for a
8 reference to anticipate a claim, the reference must disclose each and every limitation of the
9 claimed invention. In order to anticipate a dependent claim, the reference must necessarily
10 disclose each and every limitation of the claim or claims from which that dependent claim
11 depends. Logically, if Claim 2 is not anticipated, then Claim 7 cannot be anticipated.
12 *Minnesota Mining & Manufacturing Co. v. North American Science Associates Inc.*, 55
13 USPQ2d 1348, 1350 (D. Minn. 2000) ("If an independent claim . . . is not anticipated, then
14 none of the claims depending from that claim are anticipated."). For at least the reason
15 that Miwa fails to disclose a database report, the Section 102 rejection of Claim 7 must be
16 withdrawn.

✓ 17 Moreover, Miwa also fails to disclose "associat[ing] content with internal value
18 adding components created by the rightsholder" as required by Claim 7. The Examiner's
19 reference to Miwa, col 8, line 30, is inapposite as it describes the attachment of a token to
20 electronic money and disabling the token when the money is paid. This gives no
21 suggestion of "associat[ing] content with internal value adding components created by the
22 rightsholder." For this additional reason, the Section 102 rejection must be withdrawn.
23 Finally, Claim 7 depends from Claim 2 and is also patentable for the additional reasons
24 described for Claim 2 below. Applicants therefore request the Examiner withdraw the
25 Section 102 rejection of Claim 7 based on Miwa.

26 Claims 12, 26, and 33

27 Claims 12, 26, and 33 depend from Claims 1, 13, and 32, respectively, and further
28 require that "the reference database acts as a certification authority." The Examiner's sole
29 support for this rejection is "Pat '268 discloses a certification authority [col 6, lines 19-36]."
30 It appears that the Examiner is equating the use of a "token" to a certification authority.
31 The role of the database used by a certification authority is described, in part by the
32 Applicant's Specification at p. 21-22. As described above for Claim 1, Miwa fails to
33 disclose a reference database—much less a reference database that serves as a
34 certification authority. For at least these reasons, Claims 12, 26, and 33 are patentable over
35 Miwa. Applicants therefore request the Examiner withdraw the Section 102 rejections of
36 Claim 12, 26, and 33 based on Miwa.

37 Claims 13, 32 and 58 (and all claims depending therefrom)

38 The Examiner asserts that regarding claims 13, 32 and 58, Pat '268 discloses, *inter*
39 *alia*, "a reference database that stores abstracts of each at least one reference signal [Fig
40 6, inherent] [and] a comparing device that compares an abstract of said at least one query
41 signal to the abstracts stored in the reference database to determine if the abstract of said

at least one query signal matches any of the stored abstracts [Fig 6, compare]." As discussed for Claim 1 above, Miwa fails to disclose (1) "a reference database that stores abstracts of each at least one reference signal," and (2) "a comparing device that compares an abstract of said at least one query signal to abstracts stored in the reference database to determine if the abstract of said at least one query signal matches any of the stored abstracts." Therefore, for the same reasons as cited for Claim 1 above, Miwa fails to disclose each and every limitation of the claimed invention. Applicants therefore request that the Examiner withdraw the Section 102 rejection of Claims 13, 32, and 58 and their respective dependent claims, names Claims 14-31, 33-40, 51-53, 55-57, and 59-61.

Claim 16

The Examiner asserts that "Pat '268 discloses a set of related abstracts for substantially the same signal [col 7, lines 24-33]." The cited passage reads as follows:

Namely, M^i is a combination of I^1, I^2, \dots, I^n and the first to the i -th hash values. I^i is an image data block and n blocks I^1 to I^n are selected by an embedded key. H_i is the hash value of the i -th image data block and a hash value is obtained by taking I^i and up to $(i-1)$ th hash values (H^{i-1}) as an input and repeating the arithmetic operations by a number of times equal to the number of the image data blocks (n) which is the subject of the arithmetic operations. I^0 is represented by a constant and is also held in secret along with the embedded key.

The cited text describes an example of a method for generating a series of hash values for a series of image data blocks, but does not disclose a set of related abstracts for substantially the same signal. Moreover, as made evident by Claims 28 and 35, a hash is not the same as an abstract within the meaning of this Application. For this additional reason, Miwa fails to disclose each and every limitation of the claimed invention; Claim 16 therefore is patentable over Miwa. Applicants request that the Examiner withdraw the Section 102 rejection of Claim 16.

Claim 22 (and all claims depending therefrom)

Examiner asserts that "Pat '268 discloses a means to monitor the comparison difference [Fig 6, match?]" Office Action at 5. Figure 6 of Miwa shows a compare step but gives no indication of "a means for a user to monitor the comparison device" as required by Claim 22. For at least this reason, Miwa fails to disclose each and every limitation of the claimed invention; Claim 22 therefore is patentable over Miwa. Applicants request that the Examiner withdraw the Section 102 rejection of Claim 22. Moreover, for the same reasons that Claim 22 is patentable over Miwa, the claims that depend from Claim 22 also are

patentable. Applicants request the Examiner withdraw the Section 102 rejections of Claim 23-25 based on Miwa.¹

Claims 29, 38, and 56

The Examiner's sole support for these rejections is the statement that "Pat '268 discloses the reference signal is digitally signed before it is embedded [Fig 5]." Office Action at 6. Figure 5 does not disclose digitally signing a reference signal before it is embedded and there is no reference in Miwa to the use of digital signatures as required by Claims 29, 38 and 56. For at least this reason, Miwa fails to disclose each and every limitation of the claimed invention; Claims 29, 38, and 56 therefore are patentable over Miwa. Applicants request that the Examiner withdraw the Section 102 rejection of Claims 29, 38, and 56. Moreover, for the same reasons that Claims 29 and 38 are patentable over Miwa, the claims that depend from Claims 29 and 38 also are patentable. Applicants request the Examiner withdraw the Section 102 rejections of Claim 39 and 40 based on Miwa.

Claims 34 and 39

The Examiner's sole support for this rejection is the statement that "Pat '268 discloses the abstract is embedded with a predetermined key [Fig 7]." Office Action at 6. Figure 7 of Miwa does not show an abstract at all; it shows embedding a key but not in an abstract. Miwa discloses "[a] system of generating a token *using* an asymmetrical key from an abstract" and "[i]n the user side, an abstract is prepared from a distributed token *using* a publicly open key" Miwa at col. 8, lines 6-18 (emphasis added). Thus, Miwa discloses using a publicly open key to generate a token on the content owner side and to prepare an abstract from a distributed token on the user side, but provides no teaching of embedding a key in an abstract. For at least this reason, Miwa fails to disclose each and every limitation of the claimed invention; Claim 34 and 39 therefore are patentable over Miwa. Applicants request that the Examiner withdraw the Section 102 rejection of Claims 34 and 39.

Rejections under 35 U.S.C. § 103

In order to "establish a prima facie case of obviousness, three basic criteria must be met." MPEP § 7.06.02(j). First, there must be some motivation or suggestion to modify the reference or to make the proposed combination. Second, there must be a reasonable expectation of success. "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure." MPEP § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Third, the combined references must teach or suggest all claim limitations.

¹ Examiner lists Claims 23-25 among those Claims rejected under 35 U.S.C. § 102(e) as being anticipated by Miwa, but provides no separate explanation for how Miwa discloses each and every limitation of Claims 23-25.

The Examiner has failed to establish a prima facie case of obviousness to the extent that there is no motivation or suggestion to make the proposed combinations of the references as directed by the Examiner. According to the MPEP,

[i]n order to support a conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention obvious in light of the teachings of the references.

MPEP 2142 (citing *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)) (emphasis added). Further, "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of teachings is proper." MPEP 2142 (citing *Ex Parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1998)).

The Federal Circuit has recently emphasized the importance of providing evidence of motivation to combine in *Winner Int'l Royalty Corp. v. Ching-Rong Wang*, 202 F. 3d 1340, 1348-49 (Fed. Cir. Jan. 27, 2000). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another . . . the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" *Winner*, 202 F. 3d at 1348-49 (citations omitted). Further, the "absence of such a suggestion to combine is *dispositive* in an obviousness determination." *Gambro Lundia AB v. Baxter Healthcare Corp.*, 11 F.3d 1573, 1579 (Fed. Cir. 1997).

Applicant submits that the Examiner has not satisfied his initial burden of providing "clear and particular" evidence of motivation to combine for any of the proposed combinations of references. Instead, it appears that the Examiner has simply identified references that allegedly disclose the elements of the claim, and has combined them. Even assuming *arguendo* that the references contained all elements of the claimed invention, it is still impermissible to reject a claim as being obvious simply "by locating references which describe various aspects of a patent applicant's invention *without also providing evidence of the motivating force* which would impel one skilled in the art to do what the patent applicant has done." *Ex parte Levengood*, 28 USPQ2d 1300, 1303 (Bd. Pat. App. & Inter. 1993) (emphasis added).

§ 103 Rejections Based on Miwa et al. as applied to Claim 1 of Current Application further in view of Wong et al.

Claim 2 (and all claims depending therefrom)

Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Miwa as applied to claim 1 above and further in view of U.S. Patent No. 6,199,058 issued to Wong et al. (hereafter Wong). Examiner asserts that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify [Miwa] to

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include a database report as taught by [Wong] for the purpose of providing a user the current status of the database." Office Action at 7. This assertion is unsupported.

First, there is no motivation to combine Miwa with Wong. Wong describes a method for determining if a report request matches a previously generated report; Wong does not discuss the content of the reports, however. Where is the motivation for adding the method of Wong to Miwa? Without the hindsight of Applicants' invention, there is no motivation to modify Miwa to include a database report as required by Claim 2 and all claims depending therefrom. Such reliance upon Applicant's invention is impermissible. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983); *In re Rothermel*, 276 F.2d 393, 396 (CCPA 1960).

Second, even if there were motivation, the combination fails to disclose all of the elements of claim 2. Examiner concedes that Miwa "does not disclose a database report." Office Action at 7. Thus, clearly the Examiner is relying on Wong to disclose the use of a database report. As indicated above, Wong describes a method for determining if a report request matches a previously generated report. Wong does not discuss the content of the reports, and thus, there is no reason to conclude that the referenced report is a "database rights and restrictions report" as required by claim 2. For this additional reason, the rejection cannot be maintained.

Applicants therefore request that Examiner withdraw the Section 103 rejections of Claims 2 and 5-6 (which, as amended, depend from Claim 2).

§ 103 Rejections Based on Miwa et al. in view of Ullum et al.

Claim 41 (and all claims depending therefrom)

Claims 41 and 54 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Miwa in view of U.S. Patent No. 6,457,058 issued to Ullum et al. (hereafter Ullum). Examiner asserts that "[i]t would have been obvious to one of skill in the art at the time the invention was made to modify [Miwa] to include a digital signal having a known distribution address as taught by Ullum '058 for the purpose of improving RAM access [abstract]." Office Action at 10. The Examiner thus relies on Ullum's improved RAM access as motivation to combine Ullum with Miwa. This logic, however, is flawed. The Examiner refers to a "known distribution address" whereas the claim requires a "known distribution status." The logic of the Examiner's rejection of Claim 41 makes no sense when applied to a "known distribution status." Applicants request clarification or withdrawal of the Section 103 rejection of Claim 41 and Claims 42-48, which depend therefrom, because the Examiner has failed to reference the relevant claim language.

There is no motivation to combine Miwa with Ullum. Ullum describes an improved look up mechanism for accessing a RAM in a high performance switch. Miwa purports to be directed to a data control system using tokens and or control flags. As described in response to the Section 102 rejection of Claim 1, Miwa prepares abstracts from the token and from the digital content on the user side, so there is no need for a database, and hence, no need for an improved lookup mechanism as taught by Ullum. In this sense,

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Miwa teaches away from Ullum, because the tokens render superfluous any database. Without the hindsight of Applicants' invention, there is no motivation to combine the improved lookup mechanism of Ullum with the data control system of Miwa. Such reliance upon Applicant's invention is impermissible. See *W.L. Gore*, 721 F.2d at 1553; *In re Rothermel*, 276 F.2d at 396.

Applicants therefore request that Examiner withdraw the Section 103 rejections of Claims 41 and 42-48 (which depend from Claim 41).

§ 103 Rejections Based on a Combination of Miwa et al. and Ullum et al. further in view of Poole et al.

Claims 42-48 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Miwa and Ullum and further in view of U.S. Patent No. 5,920,900 issued to Poole et al. (hereafter "Poole"). As stated for Claim 41, there is no motivation to combine Miwa and Ullum. Poole does not cure this deficiency. Without the hindsight of Applicants' invention, there is no motivation to combine Poole with Miwa or Ullum. Such reliance upon Applicant's invention is impermissible. See *W.L. Gore*, 721 F.2d at 1553; *In re Rothermel*, 276 F.2d at 396.

Moreover, the combination of Ullum, Miwa, and Poole fails to disclose each and every limitation of Claims 42-48. As discussed for Claim 41 above, the combination of Miwa and Ullum fails to disclose "comparing the first digital signal abstract to at least one database of digital signal abstracts." Poole provides nothing to remedy that deficiency. At most Poole evaluates whether a hash collision has occurred to determine if further processing is required to resolve the collision so that a unique index address can be generated from each packet address. Poole does not teach comparing abstracts to a database of digital signal abstracts. For at least this reason, the combination of Miwa, Ullum, and Poole fails to disclose each and every limitation of the claimed invention. Applicants therefore request that Examiner withdraw the Section 103 rejections of Claims 42-48.

Regarding claims 42 and 43, the Examiner asserts that "Pat '900 discloses distribution of the digital signal when the digital signal abstract does not match an abstract in the database [col 3, lines 23-25]." Office Action at 11. Regarding claims 44 and 45, the Examiner asserts that "Pat '900 discloses distribution of the digital signal when the digital signal abstract does match an abstract in a database [col 3, lines 20-22]." Office Action at 11. The cited passages state:

In the first resolution area, in each entry where a collision does not occur, the first resolution table contains an index into the output table which contains the desired translated output number. In each first resolution table entry where a collision does occur, the entry contains a pointer in a second resolution area in a third hash table.

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Poole, col. 3, lines 20-26. It appears that the Examiner equates a hash collision as described in Poole to an abstract matching an abstract in a database, and the absence of a hash collision as described in Poole to the condition where the digital signal abstract does not match an abstract in the database. However, Poole defines a hash collision as the state that occurs in a hash table when two input numbers generate a hashed value, which is used to access a single location in the hash table. See Poole, col. 2, lines 26-29, 52-56; col. 9, lines 56-59; Claim 1. At best, Poole describes a method for resolving hash collisions; it does not teach a database of abstracts much less the distribution of the digital signal when the digital signal abstract does or does not match an abstract in the database. Thus, the combination of Ullum, Miwa, and Poole fails to disclose each and every limitation of Claims 42-45. For this additional reason, Applicants request the Examiner withdraw the Section 103 rejections of Claim 42-45 based on Miwa in combination with Ullum and Poole.

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Conclusion

Applicant maintains that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that an interview with Applicant's representative, either by telephone or in person, would further prosecution of this application, we would welcome the opportunity for such an interview.

It is believed that no other fees are required to ensure entry and consideration of this response. However, if necessary, the Commissioner is hereby authorized to charge the required extension fee to Deposit Account No. 50-1129. If additional fees are required to keep this case pending, or if payment cannot be made otherwise, the Commissioner is hereby authorized to take any fees necessary from Deposit Account No. 50-1129.

Respectfully submitted,

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